

## **REMARKS**

### **I. Introduction**

The following remarks are submitted in response to the non-final Office Action dated January 8, 2008. At the time when the Office Action was mailed, claims 71, 76, 81-82, and 86-101 were pending in the present patent application.

The Office Action objected to the declaration and claims 81 and 92. The Office Action rejected claims 71, 76, 81, 82, and 86-101 under 35 U.S.C. § 112, second paragraph, and claims 71, 76, 81-82, and 86-100 under 35 U.S.C. § 103(a).

By this response, Applicants have cancelled claims 71 and 76, amended claims 81-82 and 92, and added new claims 102 -105. No new matter has been added. In view of the current amendments, claims 81-82, and 86-105 are now pending in this application.

For reasons presented below, Applicants respectfully submit that the amended claims overcome all outstanding objections and rejections.

### **II. Objection to the Declaration**

The Office Action found the declaration to be defective based on the following statement: "I acknowledge the duty to disclose information which is material to the examination of this application in accordance with 37 C.F.R. § 1.56." (See, the Office Action, p. 3, section 4.) The Office Action apparently concluded that the declaration is defective for using the word "examination" instead of "patentability," in accordance with Title 37, C.F.R. § 1.56. (Id.) However, "material to examination" encompasses "material to patentability" because examination includes examining the claims to determine patentability, as well as activities outside of patentability. For example, examination includes checking for informalities. Accordingly, "material to examination" meets the requirements of 37 C.F.R. § 1.56. Therefore, Applicants respectfully request withdrawal of the Office Action's objection to the declaration.

### III. Claim Objections

The Office Action objected to claims 81 and 92 for reciting "to enable electrical current to flow" instead of "to enable *an* electrical current to flow" (emphasis added). Applicants respectfully submit that the phrase "to enable electrical current to flow" is not objectionable. In the context of claims 81 and 92, the grammar of the phrase "to enable electrical current to flow" can be compared to the grammar of phrases such as "to enable air to flow" or "to enable water to flow". In the cases of "air" and "water," it is clear that it is not necessary to recite "*an* air" or "*a* water." Similarly, given the context of the claims, it is not necessary for Applicants to recite "*an* electrical current," as suggested by the Office Action. Accordingly, Applicants respectfully request withdrawal of the objections to claims 81 and 92.

### IV. Claim Rejections – 35 U.S.C. § 112, second paragraph

The Office Action rejected claims 71, 76, 81, 82, and 86-101 as allegedly failing to "particularly point out and distinctly claim the subject matter which applicant regards as the invention." (See, the Office Action, p. 4, section 7.) In making these rejections, the Office Action noted that there is insufficient antecedent basis in claim 81 for "the terminal end" and "the solder tip," and that there is insufficient antecedent basis in claim 92 for "the terminal end".

As currently amended, claim 81 does not recite "the terminal end" or "the solder tip", and 92 does not recite "the terminal end." Accordingly, Applicants respectfully request withdrawal of the rejections of claims 71, 76, 81, 82, and 86-101 under 35 U.S.C. § 112, second paragraph.

V. Claim Rejections – 35 U.S.C. § 103(a)

The Office Action rejected claims 81-82, 92-93, 95-97, and 99-100 under 35 U.S.C. § 103(a) based on Albietz<sup>1</sup>, Walton<sup>2</sup>, Kitsuda<sup>3</sup>, and Lee<sup>4</sup>. (See, the Office Action, p. 5, section 14.) The Office Action rejected claims 86-91, 94, 98, and 101 under 35 U.S.C. § 103(a) based on Albietz, Walton, Kitsuda, and Lee, and various additional references.

The amended claims overcome these rejections for at least the following reasons.

A. Independent Claims 81 and 92

As currently amended, claims 81 and 92 each recites a switch capable of both (a) selectively disconnecting the detachable solder tip and a light from the electrical power source, and (b) powering the light and additionally powering the detachable solder tip when a short is created across the first and second electrodes. Examples of such a switch can be found in the original specification at Figure 5 and paragraphs [0028] and [0029].

The Office Action's proposed combination of Albietz, Walton, Kitsuda, and Lee fails to disclose a switch as recited in amended independent claim 81 or amended independent claim 92. Accordingly, these claims are patentable over the proposed combination.

The Office Action acknowledges that Albietz fails to disclose a switch as claimed. (See, the Office Action, p. 7, section 15) However, the Office Action asserts that Kitsuda teaches a switch for powering both a light and a heated tip at the same time. (See, the Office Action, p. 8, lines 1-6) In making this assertion, the Office Action refers to Kitsuda, col. 1, lines 10-22, which recites "means for opening or closing one or both of [a lamp circuit and an igniter circuit]", and col. 1, line 44 – col. 3, line 16, which discusses a switch 15 for controlling a lamp 6, and a different switch 18 for controlling the igniter. (See, e.g., Kitsuda, col. 3, lines 1-5.)

In Kitsuda, the switch 15 and the switch 18 are shown on opposite sides of a device. (See, Kitsuda, Figure 1.) Kitsuda explains that the switches are operated independently to

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<sup>1</sup> U.S. Patent No. 2,210,352

<sup>2</sup> U.S. Patent No. 3,899,654

<sup>3</sup> U.S. Patent No. 2,092,218

separately control the lamp 6 and the igniter unit 7: "the lamp 6 and the igniter unit 7 may be operated alternately or simultaneously by manipulating the switch 15 and/or the switch comprising the spring contact 18". (See, e.g., Kitsuda, col. 3, lines 1-5.)

Because Kitsuda uses *two different switches* to separately and independently control the lamp 6 and the igniter unit 7, Kitsuda fails to teach a switch capable of both (a) selectively disconnecting the detachable solder tip and a light from the electrical power source, and (b) powering the light and additionally powering the detachable solder tip when a short is created across the first and second electrodes, as defined in claim 81.

Accordingly, the Office Action's proposed combination of Albietz, Walton, Kitsuda, and Lee does not teach all of the features of claim 81. As a result, claim 81 is patentable over the Office Action's proposed combination of Albietz, Walton, Kitsuda, and Lee.

In view of the foregoing, Applicants respectfully request withdrawal of the current rejections and allowance of independent claims 81 and 92.

B. Dependent Claims 82, 86-91, and 93-101

Dependent claims 82, 86-91, and 93-101 overcome the current rejections based on their dependence from independent claims 81 and 92. Accordingly, Applicants respectfully request withdrawal of the current rejections and allowance of dependent claims 81-82, 86-91, and 93-101.

VI. New Claims

Claims 102 and 103 are renumbered versions of cancelled claims 71 and 76. Applicants have cancelled claims 71 and 76 and added their subject matter to claims 102 and 103 so that the claims are numbered in order of their scope, as recommended by MPEP § 608.

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<sup>4</sup> U.S. Patent No. 5,954,458

Claims 104-105 are directed to additional patentable subject matter. Claim 104 is believed to be patentable, as none of the prior art suggests a cordless soldering tool having detachable tips comprised of the particular composition of graphite as claimed.

VII. Conclusion

No other issues remaining, Applicants respectfully request withdrawal of all current objections and rejections and allowance of the current claims.

Applicants are filing concurrently herewith a 3-month Petition for Extension of Time. No other fees are believed due. However, the Commissioner is authorized to charge any additional fees deemed necessary (or credit any overpayments) to Deposit Account No. 50-2283 under order number 573878011US01.

If the Applicants' representative can be of assistance in furthering the prosecution of this case, the Examiner is encouraged to contact the undersigned at any time, at (202) 434-1607.

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